





PATENT  
Docket Number: 16356.723 (DC-01769)  
Customer No. 000027683

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: §  
Springer, David S., et al. §  
Serial No.: 09/313,436 § Group Art Unit: 3622  
Filed: May 17, 1999 § Examiner: Khanh H. Le  
For: METHOD AND APPARATUS FOR §  
TRACKING BANNER ADVERTISING §

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### PRE-APPEAL BRIEF REQUEST FOR REVIEW

Responsive to the Final Office Action, dated July 20, 2005, and the Advisory Action dated December 6, 2005, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

**1. The Rejection Of Claims 1 and 26, and their respective dependent claims, is not supported by a *prima facie* case of obviousness for Claims 1 and 26.**

Claims 1 and 26 and their respective dependent claims 4-5, 8-9, 27-28 and 30-31 are rejected under 35 U.S.C §103(a) as being unpatentable over *Guyot* (U.S. Patent No. 6,119,098) in view of *Jenkins* (U.S. Patent No. 6,285,983). A *prima facie* case of obviousness is missing, however, at least because there is no support for an obviousness rejection of the claimed subject matter as a whole because *Guyot* and *Jenkins* fail to disclose each element of the claims or suggest the missing elements.

The rejection admits that "Guyot does not specifically disclose the server is accessed by a computer manufacturer or that the credits given for viewing ads are discounts on advertised computer components from the manufacturer." and argues that it would have been obvious to one skilled in the art at the time the invention was made to apply Guyot's method to computer manufacturers to allow this type of merchant to use Guyot's method. Further, it would have been obvious to one skilled in the art at the time the invention was made to substitute to Guyot's credits given, discounts on advertised computer components for the manufacturers, in case these latter are involved, to provide credits in a form that is relevant to products that would obviously be likely to be advertised by such merchants, computer components."

The rejection also admits that "Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30) or is imbedded in the user computer hardware (claim 1) and argues that in the analogous advertising art, Jenkins discloses that "As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer" (see at least col. 1, lines 18-39).

The rejection also admits that "Guyot does not specifically disclose the information specific to the computer user includes one of incentives, bonuses and discounts on a plurality of goods, however it discloses targeted ads (abstract)" and argues that Official Notice is taken that it is well-known and customary to advertisements often include promotional offers, such as product or service discounts and vouchers to promote consumption." (includes grammatical errors from comments in Office Action).

The claimed invention provides a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

This is uniquely unlike the Guyot system which provides advertisements to subscribers based on a personal profile provided by that subscriber.

The unique identifier of the present invention is imbedded in a system hardware or software component during manufacture, which is uniquely unlike the cookie file installed on a hard disk drive of a browsing consumer in *Jenkins*.

There is no suggestion or supporting reference which teaches or suggests tracking information provided to a computer system from an advertisement database accessed by a computer manufacturer to provide discounts to users, based on a user receiving a predetermined number of advertisements that are tracked in a time period and associated with an identifier, as claimed, nor is there a teaching or suggestion of a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

**2. The Rejection Of Claims 6 and 29 is not supported by a *prima facie* case of obviousness.**

Claims 6 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Guyot* in view of *Jenkins*, and further in view of *Marsh et al.* (U.S. 5,848,397).

The rejection admits that "*Guyot* does not specifically disclose that if no matching criteria is found, the database transmitting one of generic advertisements and no advertisements," and argues that "Marsh discloses that default (generic) ads or no ads are displayed when no other criteria for display are met."

This rejection relies on a strained claim construction for the reasons set forth above relating to independent claims 1 and 26, from which claims 6 and 29 respectively depend.

Other reasons for the patentability of claims 1, 4-5, 8-9, 27-28 and 30-31 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted,



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